

The opinion in support of the decision being
entered today is not binding precedent of the Board.

Paper No. **43**

Filed by: Michael P. Tierney
Administrative Patent Judge
Box Interference
Washington, D.C. 20231
Tel: 703-308-9797
Fax: 703-305-0942

Filed
April 24, 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

APPLIED RESEARCH SYSTEMS ARS HOLDING, N.V.

Junior Party,
(U.S. Patent No. 5,272,071),

v.

CELL GENESYS, INC.

Junior Party,
(Application 08/102,390).

FAXED

APR 24 2003

**PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES**

Patent Interference No. 105,114 (MPT)

REDECLARATION

(Adding Cell Genesys Claims and Correcting ARS Claims)

Part A. Conference call

A telephone conference call was held on April 22, 2003, at approximately 2:00 p.m. The conference call involved the following participants:

1. Michael P. Tierney, Administrative Patent Judge
2. Roger L. Browdy, Charles L. Gholz, and Al Rollins, counsel for ARS.
3. Steven B. Kelber, lead counsel for Cell Genesys.

Part B. Relevant Discussion During Conference Call

The principal purpose of the conference call was to discuss Cell Genesys's request for entry of new claims 107-112 and ARS's two miscellaneous motions that seek entry of certificates of correction for their involved patent. As discussed in the conference call, and detailed below, Cell Genesys's request is *granted*; ARS Revised Miscellaneous Motion 1 is *granted*, and ARS Revised Miscellaneous Motion 2 is *denied* without prejudice.

1. Cell Genesys Request for Entry of Claims

As explained in the Notice Declaring the Interference (Paper No. 1), the APJ invited Cell Genesys to file an expedited motion under 37 C.F.R. § 1.633(c)(2) to amend or add additional claims. Responsive to the APJ's invitation, Cell Genesys filed a "Response to Paper No. 1 (Addition of Claims)." (Paper No. 10). The Response adds new claims 107-112 to the Cell Genesys 08/102,390 application and identifies the alleged written descriptive support for the added claims. Cell Genesys states that upon entry of the amendment, Cell Genesys claims 105-112 would properly correspond to Count 1, the sole count in interference.

The expedited filing and consideration of Cell Genesys' request to add new claims 107-112 aids in the efficient administration of the interference. By adding these claims early in the interference, Cell Genesys has provided a more definitive statement as to the scope of the interfering subject matter. Accordingly, Cell Genesys' request is *granted*. Yet, as claims 107-112 are added to the interference prior to receipt of an opposition from ARS, Cell Genesys shall continue to bear the burden of proof that it is entitled to add these claims to the involved

08/102,390 application, i.e., for the duration of the interference Cell Genesys shall bear the burden of proof with respect to compliance with the written description requirement for claims 107-112. *Cf.*, 37 C.F.R. § 1.637(c)(2)(iii) and Notice of the Chief Administrative Patent Judge of Nov. 6, 1998, "Interference Practice -- Interference Rules Which Require a Party to 'Show the Patentability' of a Claim," 1217 Off. Gaz. Pat. & Tm. Office 17 (Dec. 1, 1998). That the burden of proof remains with Cell Genesys is not a statement that the claims are unpatentable, but rather a recognition that the APJ has not yet considered Cell Genesys' alleged written descriptive support for the newly added claims.

The interference is hereby redeclared to reflect that Cell Genesys claims 105-112 correspond to Count 1, the sole count in interference.

2. ARS Revised Miscellaneous Motion 1

ARS requests that a certificate of correction be entered for its involved 5,272,071 patent. (Paper Nos. 4 and 11). According to ARS, most of the alleged errors are the fault of the USPTO and should be corrected under 37 C.F.R. §1.322. (See explanation, Paper No. 4, pages 3-4). Additionally, ARS notes that one of the alleged errors is a mistake of a clerical or typographical nature or of minor character that was not the fault of the USPTO, but should be corrected pursuant to 37 C.F.R. §1.323. (Paper No. 4, p. 4). Cell Genesys does not oppose the grant of this motion and consequent entry of the certificate of correction. (Paper No. 4, p. 2).

As ARS has sufficiently explained how the errors are either the fault of the USPTO or are of a minor character, the APJ grants ARS Revised Miscellaneous Motion 1 and authorizes the entry of the certificate of correction attached thereto.

3. ARS Revised Miscellaneous Motion 2

ARS has requested entry of a second certificate of correction. (Paper Nos. 5 and 12).

The certificate generally lists three errors that are to be corrected:

1. Delete Claim 4
2. In Claim 40, replace "regulatory segment" with "amplifiable gene"
3. Delete Claim 43

According to ARS, the above errors are mistakes of a clerical or typographical nature or of minor character that were not the fault of the USPTO. ARS states that the errors occurred in good faith and that their correction does not constitute new matter or require reexamination. (Paper No. 5, p. 3).

a. Alleged Duplicate Claims

As to the deletion of claims 4 and 43, ARS alleges that claim 43 is a duplicate of claim 3 and that claim 4 is a duplicate of claim 41. Since only "duplicate" claims are being deleted, ARS alleges that no legal rights are being relinquished and that a statutory disclaimer of the subject matter of the duplicate claims would be inappropriate. (Paper No. 5, p. 4).

While it is possible that the claims in question are duplicates, ARS has failed to sufficiently demonstrate that the claims are indeed duplicates. For example, claim 4 depends from claim 3 and requires at least one expressible selectable marker gene disposed so as to be

inserted with said expressible amplifiable gene of claim 3. In contrast, claim 41 depends from claim 3 and requires that the selectable marker be disposed so as to be inserted with "said" regulatory segment, a segment that is not literally recited in claim 3 nor otherwise referred to in claim 41. Hence, claims 4 and 41 may be of different scope as claim 41 could be construed as requiring the presence of a regulatory segment whereas claim 4 would not.

b. Replacement of "Regulatory Segment" with "Amplifiable Gene"

Claim 40 recites "said regulatory segment" without proper antecedent basis. Due to the lack of antecedent basis, ARS alleges that the examiner must have understood claim 40 to refer to an amplifiable gene as opposed to a regulatory segment. ARS request that each instance of regulatory segment be replaced by amplifiable gene. ARS states that no new examination would be required.

Whether the examiner intended claim 40 to require a regulatory segment is unclear from the record. For example, it is possible that the examiner and/or prosecuting attorney intended that one of the targeting sequences of claim 40 was upstream of "a" regulatory segment and the other targeting segment was downstream of said regulatory segment. (See, e.g., claim 5). As the record is unclear as to what was intended, ARS has failed to establish that the "error" in not reciting "amplifiable gene" was of a clerical, typographical or minor character. 35 U.S.C. §255. Further, the record is unclear as to whether or not the proposed amendment to claim 40 would involve the addition of new matter, which would require further examination.

c. Decision on ARS Miscellaneous Motion 2

ARS has failed to sufficiently demonstrate that the claims being deleted are duplicates or that the amendment to claim 40 was of a clerical, typographical or minor nature. Accordingly, ARS Miscellaneous Motion 2 is *denied* without prejudice as ARS has failed to demonstrate that it is entitled to the relief sought. Should the Board later determine that claim 43 is a duplicate of claim 3 and/or claim 41 is a duplicate of claim 4, ARS may request authorization to file a certificate of correction cancelling the duplicate claim(s).¹ Furthermore, this denial of the certificate of correction is without prejudice to ARS filing a reissue application to correct the listed "duplicate" claim errors.

It is:

ORDERED that the amendment (Attached to Paper No. 10) adding new claims 107-112 to Cell Genesys' involved 09/102,390 application be entered.


FURTHER ORDERED that the interference is redeclared to reflect that Cell Genesys claims 105-112 correspond to Count 1, the sole count in interference.

FURTHER ORDERED that the ARS Revised Miscellaneous Motion 1 for entry of a certificate of correction is *granted*.

FURTHER ORDERED that the ARS Revised Miscellaneous Motion 2 for entry of a certificate of correction is *denied* without prejudice.

¹In denying ARS Miscellaneous Motion 2, the APJ did not reach the issue of whether or not the use of a certificate of correction is a proper procedure for cancelling a duplicate claim. At this time the APJ is not aware of any binding precedent concerning this exact issue.

FURTHER ORDERED that a copy of this paper be placed in the files of the involved
Cell Genesys 09/102,390 application and ARS 5,272,071 patent.


MICHAEL P. TIERNEY
Administrative Patent Judge

Date: April 24, 2003
Arlington, VA

cc (via Facsimile):

Counsel for ARS:

Roger L. Browdy, Esq.
BROWDY and NEIMARK, P.L.L.C.
624 Ninth Street, N.W.
Suite 300
Washington, D.C. 20001

Tel: 202-628-5197
Fax: 202-737-3528

Backup counsel for ARS:

Charles L. Gholz, Esq.
OBLON, SPIVAK, McCLELLAND, MAIER
& NEUSTADT, P.C.
1940 Duke Street
Alexandria, VA 22314

Tel: 703-413-3000
Fax: 703-413-2220

Counsel for Cell Genesys:

Steven B. Kelber, Esq.
PIPER RUDNICK, LLP
1200 Nineteenth Street, N.W.
Washington, D.C. 20036-2430

Tel: 202-861-3900
Fax: 202-861-3877